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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,704	09/12/2003	Minas Theodore Coroneo	Q77494	7676

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/660,704

Applicant(s)

CORONEO, MINAS THEODORE

Examiner

Suzette J Gherbi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/3/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 1/28/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In particular the amendment introduces new figures 6A-6C which were not filed as part of the applicant's original disclosure. Please see 37 CFR 1.115. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

2. The drawings (for figures 6A-6C) were received on 1/28/04. These drawings are NOT ENTERED because they introduce new matter..

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the peripheral portion and the one or more haptics as introduced in the claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 12-15, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney 2003/00199976. Portney discloses the invention as claimed comprising: An IOL with an anterior and posterior surfaces [0024] defining a central visually transparent lens optic extending from the anterior to the posterior surface; and a peripheral portion outside the central lens optic, wherein the optical properties of the peripheral portion are selected such that oblique incident light focusing (see [0044]) on the peripheral portion is diminished or refracted laterally or anteriorly as opposed to posteriorly; wherein the IOL is foldable; wherein the IOL has haptics and is used for the treatment of cataracts[0007]. See sections [0011; 0024-0027; 0030; 0044; 0052; 0062-0063; 0065]).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Brady et al. 2003/0144733. Portney has been disclosed above however Portney does not specify that the peripheral portion utilizes light absorbing

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material. Brady et al. teaches an IOL that features the use of light absorbing material/color (see [ 0123]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the invention of Portney and utilize the light absorbing materials/colors as taught by Brady et al. because both IOLS function is to reduce/diminish glare and both IOLS contain peripheral portions.

Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Achatz et al. 4,813,955. Portney has been disclosed however Portney does not specify that the oblique incident light is refracted on the peripheral portion forward the nasal retina in the eye. Achatz et al. teaches an IOL in which the incident is adjusted near the nasal portion (see col.2, lines 24-39. It would have been obvious to one having ordinary skill in the art at the time the invention was made to made the lens of Portney such that the oblique incident light is directed forward of the nasal retina in the eye in order to divert it away from the retina into a location that is not effected.

9. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney. Portney has been disclosed above however Portney does not specify the oblique incident light angle of 71-89 degrees. However it appears that the angle of oblique incident may fall within this range noting figures 9 and 17. Applicant has not disclosed that having an oblique incident in these specific ranges solves any stated

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problem or is for any particular purpose. Moreover, it appears that the oblique incident angles of Portney would perform equally well with the lens of Portney's angles and still solve the problem of diminishing glare. Accordingly the use of angles between 71-89 degrees is deemed to be a design consideration, which fails to patentably distinguish over the prior art of Portney

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Portney 6,596,025; LeBoeuf et al. 6,406,739 ; Peyman et al. 6,280,471 ; and Kelman 2004/0064182 all show related material..

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.

12. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Suzette J-J Gherbi  
05 February 2005